

REMARKS

Claims 29, 33, 34, 36-40, 54-55, 57, 59 and 61-66 have been amended. New claims 67-71 have been added. Claims 1-28, 53 and 56 have been canceled without prejudice. Applicants confirm the election of Group II without traverse. Claims 29-52, 54-55, and 57-71 are currently pending in the application. Support for the claim amendments and new claims can be found throughout the originally filed specification and drawings. (*See, e.g.*, Figs 1 and 8; page 11, line 19 – page 13, line 15). No new matter has been added. Reconsideration and allowance of the application, as amended, are respectfully requested.

I. Claims 29-36, 44-46, 54-55, 57-62, 64 and 65 Are Allowable Over Scheldrup

Independent claim 29 and dependent claims 30-36, 44-46, 54-55, 57-62 and 64-65 stand rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 5,669,905 to Scheldrup *et al.* (“Scheldrup”). However, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Applicants respectfully traverse these rejections, since Scheldrup does not anticipate independent claim 29, as amended, (and, thus, by extension), dependent claims 30-36, 44-46, 54-55, 57-62 and 64-65.

Scheldrup does not disclose or suggest the presence of an electrical measurement device that is configured to (i) “monitor an electrical condition related to a position of the temporary connection while the temporary connection is joined to the implant and the delivery member, the electrical condition changing when the temporary connection reaches a predetermined location,” and (ii) “generate an output signal in response to the changed electrical condition, the output signal indicating that the temporary connection has reached the predetermined location” (i.e., before the temporary connection is broken), as required by amended claim 29. In particular, claim 29, as amended, recites that the electrical measurement device is configured to generate an output that indicates that the temporary connection is at a particular, pre-determined location (i.e., and can then be broken), as opposed to indicating a change in an electrical condition that results from, or follows, breaking of the temporary connection.

Scheldrup does not disclose or suggest any such output generated before the temporary connection is broken. The Office Action refers to Scheldrup disclosing a change in impedance. However, this change in impedance is following detachment of a coil; there is no output disclosing an impedance change prior to coil detachment, and the change in impedance occurs as

a direct result of (i.e., after) detachment of the coil, or after a connection has been broken. (*See, e.g.* Scheldrup, col. 1, line 15; col. 3, lines 66-67; col. 4, lines 12-15; col. 10, lines 28-29). Accordingly, Scheldrup does not anticipate amended claim 29, and Applicants respectfully request that the rejection of claim 29 over Scheldrup be withdrawn. Dependent claims 30-36, 44-46, 54-55, 57-62 and 64-65 depend from and incorporate all of the elements and limitations of independent claim 29, and are therefore allowable over Scheldrup for at least the same reasons.

Further, Scheldrup fails to disclose or suggest “a visual indicator, the electrical measurement device being configured to provide the output signal to the visual indicator so that the visual indicator can be illuminated after the electrical condition has changed” as recited in claim 54. Page 6 of the Office Action admits that Scheldrup fails to disclose a visual signal. Additionally, in contrast to claims 29 and 54, Scheldrup discloses emitting beeps to indicate “that coil detachment has occurred.” (Scheldrup, col. 10, lines 33-34).

Additionally, Scheldrup fails to disclose or suggest “an audio indicator, the electrical measurement device being configured to provide the output signal so that the audio indicator can be activated after the electrical condition has changed” as recited in claim 55. While Scheldrup may disclose emitting beeps, these beeps are emitted after the coil has been detached. (*See*, Scheldrup, col. 10, lines 33-34).

Still further, Scheldrup fails to disclose or suggest “a controller, the electrical measurement device being configured to provide the output signal to the controller, the controller being configured to automatically break the temporary connection in response to the output signal after the electrical condition has changed” as recited in claim 57. Instead, as discussed above, Scheldrup explains that the impedance changes as a result of or after the coil has already been detached. Additionally, as admitted by the Office Action, Scheldrup does not disclose or suggest “an insulative member between the implant and the temporary connection” as recited in claim 58.

Scheldrup also fails to disclose or suggest claims 59-61, which recite limitations related to changes in electrical condition based on a location of a temporary connection relative to a distal end of a catheter and when the temporary connection reaches or passes the distal end of the catheter. Instead, Scheldrup explains that the change of impedance occurs as a result of detachment of a coil (i.e., dissolving of sacrificial link 106) and that the sacrificial link is not dissolved for 1-10 minutes.

Further, Scheldrup does not disclose or suggest “the electrical measurement device being configured to compare a reference current with a second current that is generated when the temporary connection reaches the predetermined location, the second current being larger than the reference current” as recited in claim 62. Rather, Scheldrup explains that impedance increases as a result of the sacrificial link disintegrating. (Scheldrup, col. 3, lines 45-48).

II. Claim 37 Is Patentable Over Scheldrup and Palermo

Dependent claim 37 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Scheldrup and U.S. Patent No. 5,250,071 to Palermo (“Palermo”). To establish a prima facie case of obviousness of a claim under 35 U.S.C. §103(a), all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.

Palermo is cited for the limited purpose of assertedly disclosing a temporary mechanical connection. Palermo, however, does not cure the deficiencies of Scheldrup with respect to independent claim 29. Consequently, even if the asserted combination were made, the combination would nevertheless fail to disclose each and every limitation of claims 29 and 37. Thus, Applicants respectfully submit that the rejection of claim 37 under §103(a) cannot stand. MPEP §2143.03 (if an independent claim is nonobvious, then any claim depending therefrom is nonobvious).

III. Claims 38 and 39 Are Patentable Over Scheldrup and Guglielmi

Dependent claims 38 and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Scheldrup and U.S. Patent No. 5,569,245 to Guglielmi et al. (“Guglielmi”). Guglielmi is cited for the limited purpose of assertedly disclosing temporary connections broken by heat and RF radiation. Guglielmi, however, does not cure the deficiencies of Scheldrup with respect to independent claim 29. Accordingly, even if the asserted combination were made, the combination would fail to disclose each and every limitation of claims 29, 38 and 39. Thus, Applicants respectfully submit that the rejection cannot stand. MPEP §2143.03.

IV. Claim 40 Is Patentable Over Scheldrup and Sepetka

Dependent claim 40 is rejected under 35 U.S.C. §103(a) as being unpatentable over Scheldrup and U.S. Patent No. 5,814,062 to Sepetka et al. (“Sepetka”). Sepetka is cited for the

limited purpose of assertedly disclosing a connection that is hydraulically broken. Sepetka, however, does not cure the deficiencies of Scheldrup with respect to independent claim 29. Accordingly, even if the asserted combination were made, the combination would fail to disclose each and every limitation of claims 29 and 40. Thus, Applicants respectfully submit that the rejection of claim 40 under §103(a) cannot stand. MPEP §2143.03.

V. Claims 41-43 and 47-52 Are Patentable Over Scheldrup

Dependent claims 41-43 and 47-52 are rejected under 35 U.S.C. §103(a) as being unpatentable over Scheldrup as applied to claim 29. Applicants respectfully submit that the rejection of dependent claims 41-43 and 47-52 under §103(a) cannot stand in view of the deficiencies of Scheldrup as discussed above. MPEP §2143.03.

VI. Claim 63 Is Patentable Over Scheldrup and Cheng

Dependent claim 40 is rejected under 35 U.S.C. §103(a) as being unpatentable over Scheldrup and U.S. Patent No. 6,296,636 to Cheng et al. (“Cheng”). Cheng is cited for the limited purpose of assertedly disclosing a comparison circuit that compares a threshold current to a current measured by an electrical measurement device. Cheng, however, does not cure the deficiencies of Scheldrup with respect to independent claim 29. Accordingly, even if the asserted combination were made, the combination would fail to disclose each and every limitation of claims 29 and 63. Thus, Applicants respectfully submit that the rejection of dependent claim 63 under §103(a) cannot stand. MPEP §2143.03.

Further, Applicants respectfully submit that the required suggestion or motivation to combine Scheldrup and Cheng is lacking since Cheng is directed to ablation or coagulation of tissue and limiting the amount of power delivered during electrosurgery, whereas Scheldrup is relates to methods for ensuring endovascular occlusion. (*Cf.* Cheng, col. 3, lines 48-55; Scheldrup, Abstract).

VII. New Claims 67-71 Are Patentable over Scheldrup

As discussed above, Scheldrup does not disclose or suggest a current measurement device configured to (i) monitor the electrical current from the power supply and through the delivery member and the temporary connection, the electrical current being related to a position of the temporary connection before the temporary connection is broken, with the electrical

current increasing from an first current level to a second, higher current level when the temporary connection reaches a predetermined location, and (ii) generate an output signal in response to the second current level, the output signal indicating that the temporary connection is at the predetermined location, as recited by new claim 67. The deficiencies of Scheldrup relative to new dependent claims 68-71 are discussed above.

CONCLUSION

Applicants respectfully submit that the application is in condition for allowance in view of the forgoing amendments and remarks. If there are any remaining issues that can be resolved by telephone, Applicants invite the Examiner to contact the undersigned at the number indicated below.

Respectfully submitted,

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